

IV. REMARKS

Status of the Claims

Claim 1-5 and 28 are amended and claims 29-33 are added. Claims 1-5, and 28-33 are now under consideration.

Summary of the Office Action

Claims 1-2 and 28 stand rejected under 35USC102(e) on the basis of the cited reference Castiel, U.S. Patent No. 6,249,672. Claims 3-5 stand rejected under 35USC103(a) based on the cited reference Castiel in view of the cited reference Holmberg, U.S. Patent No. 6,568,956.

Applicant submits that the amendment to claim 4 remedies the rejection under 35USC112.

The Invention

As described in amended claim 1, the telephone of this invention is contained within a body part that is mounted for sliding motion on grip part. The grip part is a shell that can be grasped by the user and supports the body portion in its extended use position. The cited references do not teach such a device either individually or in combination.

Discussion of the Cited References

The Examiner relies primarily on the reference Castiel to support both the rejection based on anticipation and the rejection based on obviousness. The reference Castiel describes a cellular telephone that is constructed in two modules. One module (102) holds the display and a portion of the electronics, such as a transceiver, and the other module (104) holds the keyboard and

other electronic components. Module 102 slides with respect to module 104. Judging from the compressed configuration of figure 3, it would appear that it is module 102 that is intended to be held, as it would be difficult to do otherwise in the compressed condition. This may cause reception difficulties as the antenna will be in the shadow of the hand. In addition the effective impedance of the antenna may be altered by the proximity of the hand causing mismatch between antenna and feed line. Using a separate grip part as in the subject device, assists in isolating the antenna from the user.

There is no sleeve-like grip part described in the reference Castiel. The device of Castiel is constructed of two body modules neither of which is specifically designed with grasping in mind. The grip part of the subject invention does not house any of the main electronics of the telephone, but is constructed primarily to provide a grip for the extended body of the telephone. This is significantly different than either of the body modules 102 and 104 of Castiel.

The cited reference Holmberg describes a mechanism for holding and releasing a battery pack for a radio telephone. It does not remedy the deficiencies in the disclosure of Castiel indicated above.

The Issue of Anticipation

It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

"...it must be shown that the reference contains all of the

elements of the claims apart from irrelevant or merely extraneous variations, and the elements are arranged in the same way to achieve the same result which is asserted to be an inventive function..." 454 U.S. 1129 (1981)

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to the device of the reference Castiel, it becomes clear that the device is missing a significant element of independent claim 1 of the subject invention. There is no provision in the system of Castiel for providing a grip part that supports the body of the telephone. Claim 1 states:

"a sleeve-like grip part adapted to be held by a user during use and constructed to receive said body part for longitudinal slidable movement of said body part on said grip part, between a retracted position and an extended position,"

Since this element forms no part of the device of Castiel, there would be no infringement if Castiel was later, therefore, the cited reference Castiel does not support the rejection by the Examiner based on anticipation.

The above arguments are equally applicable to the rejected dependent claims 2 and 28.

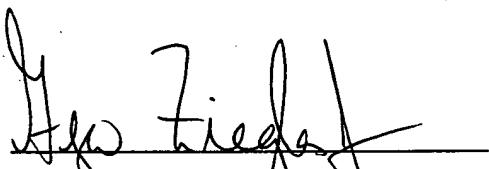
In view of the above deficiencies of the teaching of Castiel, the combination proposed by the Examiner does not support the rejection under 35USC 103(a). There is nothing in the reference Holmberg with reference to a gripping part.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

Should any unresolved issues remain with respect to this election, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza C. Ziegler, Jr.

Reg. No. 44,004

12 March 2004

Date

Perman & Green, LLP

425 Post Road

Fairfield, CT 06824

(203) 259-1800

Customer No.: 2512

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